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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,738	01/05/2001	Michelle R. Sandholm	ISAA0011	3743

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EXAMINER
OUELLETTE, JONATHAN P

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 05/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<table>
<tr>
<td rowspan="2">**Office Action Summary**</td>
<td>Application No.

09/755,738</td>
<td>Applicant(s)

SANDHOLM ET AL.</td>
</tr>
<tr>
<td>Examiner

Jonathan Ouellette</td>
<td>Art Unit

3629</td>
</tr>
</table>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 January 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-48 and 50-85* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-48 and 50-85* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Request for Continued Examination

1. The Request filed on 1/11/2006 for Continued Examination (RCE) under 37 CFR 1.114

based on parent Application No. 09/755,738 is acceptable and a RCE has been established.

An action on the RCE follows.

Response to Amendment

2. Claims 49 has been cancelled; therefore <u>Claims 1-48 and 50-85</u> are currently pending in

application 09/755,738.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **<u>Claims 1-8, 14-30, 35, 38-42, 48, 50-73, and 79-82</u> are rejected under 35 U.S.C. 102(b) as**

being anticipated by Roman (Roman, Ernan, "The Underachieving Database,"

American Demographics Marketing Tolls Supplement, pp: 48-55, June 1996).

5. As per **independent Claim 1**, Roman discloses a method for developing a multi-channel

marketing database in a computer network, which database provides a service offering that

enables marketing strategies across multiple customer touchpoints using various

communications media and methods (pg.2, direct-mail, telemarketing), said method comprising the steps of: providing a first phase for planning (pg.2); responsive to said providing a first phase for planning, providing, second phase for discovery, comprising business and technical requirements gathering (pgs. 2-3, defining database objectives); responsive to said providing a second phase for discovery, providing a third phase for design, comprising reviewing data analysis and determining specifications; responsive to said providing a third phase for design, providing a fourth phase for development comprising creating a physical data model, creating and modifying software programs and performing unit and system test on the computer network (pg.3, design and develop using off-the shelf package and completed trial runs); and responsive to said providing a fourth phase for development, providing a fifth phase for deployment (pg.3, integrated sales database information).

6. As per Claim 2, Roman discloses wherein once said five phases are complete, an on-going support and maintenance mode is provided (pg.7, updating information).

7. As per Claim 3, Roman discloses wherein said method is again followed if enhancement projects are required once said five phases are complete (pg.4, flexible system).

8. As per Claim 4, Roman discloses wherein said planning step further comprises the step of: project formation (pgs. 2-3 equivalent project planning terminology).

9. As per Claim 5, Roman discloses wherein said project formation step further comprises the step of: review client expectations (pgs. 2-3, Sales needs/wants).

10. As per Claim 6, Roman discloses wherein said project formation step further comprises the step of: defining project participants and roles (pgs. 2-3).

11. As per Claim 7, Roman discloses wherein said project formation step further comprises the step of: creating a project plan (pgs. 2-3).

12. As per Claim 8, Roman discloses wherein said planning step further comprises the step of: project initiation (pgs. 2-3).

13. As per Claim 14, Roman discloses wherein said discovery step further comprises the step of: business requirements gathering (pgs. 2-3).

14. As per Claim 15, Roman discloses wherein said business requirements gathering step further comprises the step of: reviewing a client's mission statement and business objectives (pgs. 2-3, equivalent to requirements).

15. As per Claim 16, Roman discloses wherein said business requirements gathering step further comprises the step of: reviewing a client's organizational structure (pgs. 2-3, equivalent to requirements).

16. As per Claim 17, Roman discloses wherein said business requirements gathering step further comprises the step of: reviewing a client's product and/or service offerings (pgs. 2-3, equivalent to requirements).

17. As per Claim 18, Roman discloses wherein said business requirements gathering step further comprises the step of: reviewing a client's target market and competition (pgs. 2-3, equivalent to requirements).

18. As per Claim 19, Roman discloses wherein said business requirements gathering step further comprises the step of: reviewing a client's campaign management strategies (pgs. 2-3, equivalent to requirements).

19. As per Claim 20, Roman discloses wherein said business requirements gathering step further comprises the step of: reviewing a client's critical success factors (pgs. 2-3, equivalent to requirements).

20. As per Claim 21, Roman discloses wherein said discovery step further comprises the step of: multi-channel marketing database requirements gathering (pgs. 2-3).

21. As per Claim 22, Roman discloses wherein said multi-channel marketing database requirements gathering step further comprises the step of: reviewing multi-channel marketing database reports and templates (pgs. 2-3).

22. As per Claim 23, Roman discloses wherein said multi-channel marketing database requirements gathering step further comprises the step of: reviewing a client's additional requirements (pgs. 2-3).

23. As per Claim 24, Roman discloses wherein said multi-channel marketing database requirements gathering step further comprises the step of: reviewing multi-channel marketing database data feeds (pgs. 1-9).

24. As per Claim 25, Roman discloses wherein said multi-channel marketing database requirements gathering step further comprises the step of: reviewing multi-channel marketing database calculations (pgs. 1-9).

25. As per Claim 26, Roman discloses wherein said multi-channel marketing database requirements gathering step further comprises the step of: reviewing multi-channel marketing database update requirements (pgs. 1-9).

26. As per Claim 27, Roman discloses wherein said multi-channel marketing database
requirements gathering step further comprises the step of: reviewing multi-channel marketing
database access requirements (pgs. 1-9).

27. As per Claim 28, Roman discloses wherein said discovery step further comprises the step of:
technical requirements gathering (pgs. 2-3).

28. As per Claim 29, Roman discloses wherein said technical requirements gathering step further
comprises the step of: reviewing connectivity, user access, and support requirements (pgs. 1-
9).

29. As per Claim 30, Roman discloses wherein said technical requirements gathering step further
comprises the step of: reviewing retention, backup, and security requirements (pgs. 1-9).

30. As per Claim 35, Roman discloses wherein said design step further comprises the step of:
ordering multi-channel marketing database software (pgs. 2-3).

31. As per Claim 38, Roman discloses wherein said conducting a design meeting step further
comprises the step of: data mapping (pgs. 1-9).

32. As per Claim 39, Roman discloses wherein said conducting a design meeting step further
comprises the step of: data analysis review (pgs. 1-9).

33. As per Claim 40, Roman discloses wherein said conducting a design meeting step further
comprises the step of: updating database specifications (pgs. 1-9).

34. As per Claim 41, Roman discloses wherein said conducting a design meeting step further
comprises the step of: determining calculations specifications (pgs. 1-9).

35. As per Claim 42, Roman discloses wherein said conducting a design meeting step further comprises the step of: determining mapping, report, and query template specifications (pgs. 1-9).

36. As per Claim 48, Roman discloses wherein said development step further comprises the step of: analyzing test load and update files (pgs.2-3, design and development).

37. As per Claim 50, Roman discloses wherein said development step further comprises the step of: creating/modifying specifications (pgs. 2-3).

38. As per Claim 51, Roman discloses wherein said creating/ modifying specifications step further comprises the step of: performing data preparation and determining integration specifications for initial load and on-going updates (pgs.2-3, design and development).

39. As per Claim 52, Roman discloses wherein said creating/ modifying specifications step further comprises the step of: developing database management specifications for initial load and on-going updates (pgs.2-3, design and development).

40. As per Claim 53, Roman discloses wherein said creating/ modifying specifications step further comprises the step of: developing report specifications (pgs.2-3, design and development).

41. As per Claim 54, Roman discloses wherein said creating/ modifying specifications step further comprises the step of: developing query templates specifications (pgs.2-3, design and development).

42. As per Claim 55, Roman discloses wherein said creating/ modifying specifications step further comprises the step of: creating a test database (pgs. 2-3).

43. As per Claim 56, Roman discloses wherein said development step further comprises the step of: creating one or more unit and system test plans (pgs. 2-3).

44. As per Claim 57, Roman discloses wherein said creating one or more unit and system test plans step further comprises the step of: data preparation and developing integration test plans for initial load and on-going updates (pgs.2-3, design and development).

45. As per Claim 58, Roman discloses wherein said creating one or more unit and system test plans step further comprises the step of: developing database management test plans for initial load and on-going updates (pgs.2-3, design and development).

46. As per Claim 59, Roman discloses wherein said creating one or more unit and system test plans step further comprises the step of: developing report test plans (pgs.2-3, design and development).

47. As per Claim 60, Roman discloses wherein said creating one or more unit and system test plans step further comprises the step of: developing query template test plans (pgs.2-3, design and development).

48. As per Claim 61, Roman discloses wherein said development step further comprises the step of: creating/modifying programs and routines (pgs.2-3, design and development).

49. As per Claim 62, Roman discloses wherein creating/modifying programs and routines step further comprises the step of: data preparation and developing integration programs for initial load and on-going updates (pgs.2-3, design and development).

50. As per Claim 63, Roman discloses wherein creating/modifying programs and routines step further comprises the step of: developing database management programs for initial load and on-going updates (pgs.2-3, design and development).

51. As per Claim 64, Roman discloses wherein creating/modifying programs and routines step further comprises the step of: developing report programs (pgs.2-3, design and development).

52. As per Claim 65, Roman discloses wherein creating/modifying programs and routines step further comprises the step of: developing query templates (pgs.2-3, design and development).

53. As per Claim 66, Roman discloses wherein said development step further comprises the step of: performing unit/system tests (pgs. 2-3).

54. As per Claim 67, Roman discloses wherein said performing unit/ system tests step further comprises the step of: data preparation and developing integration tests for initial load and on-going updates (pgs.2-3, design and development).

55. As per Claim 68, Roman discloses wherein said performing unit/ system tests step further comprises the step of: developing database management tests for initial load and on-going updates (pgs.2-3, design and development).

56. As per Claim 69, Roman discloses wherein said performing unit / system tests step further comprises the step of: developing reports (pgs.2-3, design and development).

57. As per Claim 70, Roman discloses wherein said performing unit / system tests step further comprises the step of: developing query templates (pgs.2-3, design and development).

58. As per Claim 71, Roman discloses wherein said development step further comprises the step of: processing test data and populating a test database (pgs.2-3, design and development).

59. As per Claim 72, Roman discloses wherein said development step further comprises the step of: establishing retention, backup, and security procedures (pgs.2-3, design and development).

60. As per Claim 73, Roman discloses wherein said development step further comprises the step

of: configuring internal end-user tools (pgs.2-3, design and development).

61. As per Claim 79, Roman discloses wherein said deployment step further comprises the step

of: analyzing live load files (pgs. 2-3).

62. As per Claim 80, Roman discloses wherein said deployment step further comprises the step

of: creating a live database (pgs. 2-3, integrating Sales Data).

63. As per Claim 81, Roman discloses wherein said creating a live database step further

comprises the step of: processing live data and populating a live database (pgs. 2-3).

64. As per Claim 82, Roman discloses wherein said deployment step further comprises the step

of: carrying out a deployment plan (pgs. 2-3).

Claim Rejections - 35 USC § 103

65. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth
> in section 102 of this title, if the differences between the subject matter sought to be patented and the
> prior art are such that the subject matter as a whole would have been obvious at the time the invention
> was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability
> shall not be negatived by the manner in which the invention was made.

66. **<u>Claims 9-13, 31-34, 36, 37, 43-47, 74-78, and 83-85</u> are rejected under 35 U.S.C. 103(a)**

as being unpatentable over Roman in view of Official Notice.

67. As per **independent Claim 85**, Roman discloses a method for developing a multi-channel

marketing database in a computer network, which database provides a service offering that

enables multi-channel marketers to analyze, create, track, control, coordinate, and execute

marketing strategies across multiple customer touchpoints using various communications

media and methods (pg.2, direct-mail, telemarketing), said method comprising the steps of:

providing a first phase for planning (pg.2) in which a team is identified from both a company

and a client side; responsive to said providing a first phase for planning, providing, second

phase for discovery (pgs. 2-3, defining database objectives), where both business and

technical requirements are identified and documented in a discovery document (pgs. 2-3);

responsive to said providing a second phase for discovery, providing a third phase for design

to determine specification for data mapping, update rules, calculations, reports, and campaign

management, wherein developed information is documented in a design document (common

company project planning process); responsive to said providing a third phase for design,

providing a fourth phase for development in which said company creates a physical data

model and unit and system test plans for the computer network, creates and modifies actual

software programs and routines on the computer network, and on the computer network

performs unit and system tests based upon specifications outlines in said design document;

wherein said company also establishes retention, back-up, and security procedures and

configures end-user tools; and wherein output from this phase is a deployment plan which is

shared with said client (pg.3, design and develop using off-the shelf package and completed

trial runs); and responsive to said providing a fourth phase for development, providing a fifth

phase for deployment; wherein said company also analyzes final load files from said client

and loads a database with live data; wherein said company provides end-user tool training

and access to data as outlined in said deployment plan (pg.3, integrated sales database

information).

68. Roman fails to disclose each and every project management step disclosed by the instant

invention, to include: planning a meeting, holding a meeting, obtaining approval of project

steps from the customer, and providing a post project review to the customer.

69. However, Official Notice is Taken that all of these steps were common business project plan

elements/processes at the time the invention was made, and it would have been obvious to

one of ordinary skill in the art to include these steps when integrating the marketing database

development plan as disclosed by Roman, for the purpose of more effectively implementing

the project plan according to common project plan techniques and strategies.

70. As per Claim 9, Roman discloses wherein said project initiation step further comprises the

step of: planning a client kick-off meeting (pgs. 2-3, normal component of business project

planning process, see rejection of independent Claim 85).

71. As per Claim 10, Roman discloses wherein said project initiation step further comprises the

step of: reviewing client executive sponsor responsibilities (pgs. 2-3, normal component of

business project planning process, see rejection of independent Claim 85).

72. As per Claim 11, Roman discloses wherein said project initiation step further comprises the

step of: establishing project communication standards (pgs. 2-3, normal component of

business project planning process, see rejection of independent Claim 85).

73. As per Claim 12, Roman discloses wherein said project initiation step further comprises the

step of: preparing company team members (marketing dept or IS dept) for discovery (pgs. 2-

3, normal component of business project planning process, see rejection of independent

Claim 85).

74. As per Claim 13, Roman discloses wherein said discovery step further comprises the step of:

conducting a client kick-off meeting (pgs. 2-3, normal component of business project

planning process, see rejection of independent Claim 85).

75. As per Claim 31, Roman discloses wherein said technical requirements gathering step further

comprises the step of: reviewing future migration requirements (pgs. 2-3, normal component

of business project planning process, see rejection of independent Claim 85).

76. As per Claim 32, Roman discloses wherein said discovery step further comprises the step of:

discovery document compilation (pgs. 2-3, normal component of business project planning

process, see rejection of independent Claim 85).

77. As per Claim 33, Roman discloses wherein said discovery step further comprises the step of:

discovery document delivery (pgs. 2-3, normal component of business project planning

process, see rejection of independent Claim 85).

78. As per Claim 34, Roman discloses wherein said design step further comprises the step of:

preparing company team members for design (pgs. 2-3, normal component of business ·

project planning process, see rejection of independent Claim 85).

79. As per Claim 36, Roman discloses wherein said design step further comprises the step of:

planning a design meeting (pgs. 2-3, normal component of business project planning process,

see rejection of independent Claim 85).

80. As per Claim 37, Roman discloses wherein said design step further comprises the step of:

conducting a design meeting (pgs. 2-3, normal component of business project planning

process, see rejection of independent Claim 85).

81. As per Claim 43, Roman discloses wherein said conducting a design meeting step further comprises the step of: determining campaign management specifications and schedules (pgs. 1-9).

82. As per Claim 44, Roman discloses wherein said design step further comprises the step of: design document compilation (pgs. 2-3, normal component of business project planning process, see rejection of independent Claim 85).

83. As per Claim 45, Roman discloses wherein said design step further comprises the step of: design document delivery (pgs. 2-3, normal component of business project planning process, see rejection of independent Claim 85).

84. As per Claim 46, Roman discloses wherein said development step further comprises the step of: planning a development meeting (pgs. 2-3, normal component of business project planning process, see rejection of independent Claim 85).

85. As per Claim 47, Roman discloses wherein said development step further comprises the step of: conducting a development meeting (pgs. 2-3, normal component of business project planning process, see rejection of independent Claim 85).

86. As per Claim 74, Roman discloses wherein said development step further comprises the step of: preparing for deployment tool training (pgs. 2-3, normal component of business project planning process, see rejection of independent Claim 85).

87. As per Claim 75, Roman discloses wherein said development step further comprises the step of: preparing for a deployment plan (pgs.2-3, sales data integration).

88. As per Claim 76, Roman discloses wherein said development step further comprises the step of: preparing for a deployment meeting (pgs. 2-3, normal component of business project planning process, see rejection of independent Claim 85).

89. As per Claim 77, Roman discloses wherein said deployment step further comprises the step of: planning a deployment meeting (pgs. 2-3, normal component of business project planning process, see rejection of independent Claim 85).

90. As per Claim 78, Roman discloses wherein said deployment step further comprises the step of: conducting a deployment meeting (pgs. 2-3, normal component of business project planning process, see rejection of independent Claim 85).

91. As per Claim 83, Roman discloses wherein said deployment step further comprises the step of: conducting a company post-project review (pgs. 2-3, normal component of business project planning process, see rejection of independent Claim 85).

92. As per Claim 84, Roman discloses wherein said deployment step further comprises the step of: conducting a client post-project review (pgs. 2-3, normal component of business project planning process, see rejection of independent Claim 85).
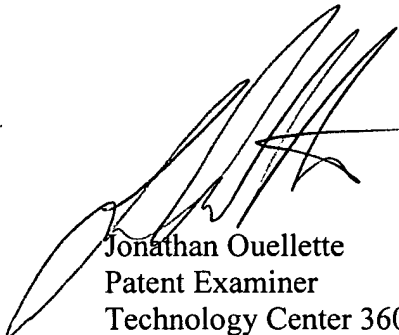
Response to Arguments

93. Applicant's arguments filed 1/11/2006 have been considered, but are moot in view of the new ground(s) of rejection.

Conclusion

94. The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

95. Additional Literature has been referenced on the attached PTO-892 form, and the Examiner

suggests the applicant review these documents before submitting any amendments.

96. Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The

examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.

97. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization

where this application or proceeding is assigned (571) 273-8300 for all official

communications.

98. Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the Office of Initial Patent Examination whose telephone number is

(703) 308-1202.

May 8, 2006

Jonathan Ouellette
Patent Examiner
Technology Center 3600